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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,150	09/04/2001	Kenichiro Kami	12-006	9102
23400	7590	05/30/2006	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			DOVE, TRACY MAE	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/944,150	Applicant(s) KAMI ET AL.	
	Examiner Tracy Dove	Art Unit 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,23,24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) 24,26 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,23 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the communication filed on 3/20/06. Applicant's arguments have been considered, but are not persuasive. Claims 20, 23, 24 and 26-28 are pending. Claims 24, 26 and 28 are withdrawn from consideration.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/05 has been entered.

Election/Restrictions

Applicant's election without traverse of Group III in Paper No. 10 is acknowledged. Election without traverse of polymer material species "polybutylene terephthalate" and modifier material species " γ -(methacryloxypropyl) triethoxy silane" in the response filed on 11/23/04 is acknowledged. Applicant states claims 20, 21, 23, 27 and 28 read on the elected species. However, claim 28 does not read on the elected species because the claim requires two modifier materials. Claims 24, 26 and 28 are withdrawn because they are directed toward a nonelected species.

Specification

The amendment filed 11/29/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

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supported by the original disclosure is as follows: on page 8 the specification has been amended to recite “or the derivatives thereof”, which is considered new matter. A polymer material that is modified is not equivalent to a derivation of the polymer material that is modified.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Analysis

The claims recite the transitional phrase “composed of”, which has been interpreted in the same manner as either “consisting of” or “consisting essentially of,” depending on the facts of the particular case. See MPEP 2111.03.

The claims recite “for a non-aqueous electrolyte secondary battery”, which is not given patentable weight because it is an intended use limitation.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20, 23 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20 recites “the polymer material is selected from the group consisting of ...and derivatives thereof”, which is not supported by the specification. The addition of “derivatives thereof” is not supported by the specification as filed.

Additionally, claim 20 recites “the first modifier...having a predetermined substituent different from the functional group of the modified polymer material”, which is not supported by the specification as filed. The specification recites “a compound having a polymerization group may be used as a modifier. In this specification, the term ‘the polymerization group’ is defined as a functional group such as the unsaturated multiple bond...reactive with itself or a polymer compound forming a porous film” (bottom page 26). Therefore, the “functional group” is part of the “modifier” material, not the “polymer” material of the claimed invention. The specification discloses a modifier having a functional group.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20, 23 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation “the functional group of the modified polymer material”. This limitation lacks antecedent basis and it is unclear what “a functional group of the modified polymer material” encompasses or how “a functional group of the modified polymer material” is defined.

To the extent the claims are understood in view of the rejections above, note the following prior art rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamanaka et al., US 5,852,108.

Yamanaka teaches a reinforced resin composition comprising a composite particulate material and a thermoplastic resin material (D). The composite material contains an inorganic material (A) and an elastic polymer material (B). The inorganic material (A) may be surface treated with a silane compound such as γ -methacryloxypropyltrimethoxysilane (2:57-3:3). The elastic polymer (B) has functional groups capable of forming chemical bonds with the resin to be reinforced. The term “functional groups” is meant to include functional groups capable of forming covalent bonds through chemical reactions with the thermoplastic resin (D) (3:4-31). The elastic polymer (B) may contain a γ -methacryloxypropyltrimethoxysilane unit (5:52-54). Typical examples of thermoplastic resin (D) include polyester resin such as polybutyleneterephthalate. Yamanaka teaches polybutyleneterephthalate is a preferred thermoplastic resin due the balanced mechanical properties and moldability (8:10-9:19).

Note canceled claim 21 has been incorporated into claim 20. Applicant stated claim 21 reads on the elected species. Since Yamanaka teaches the elected species, the claims are anticipated.

Response to Arguments

Applicant's arguments filed 11/29/05 have been fully considered but they are not persuasive.

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Applicant argues Yamanaka fails to teach or suggest that "a predetermined substituent is bonded to a second modifier having a -SiOSi- structure". However, this argument is not commensurate in scope with the claimed invention because claim 20 no longer contains the limitation. The limitation "a predetermined substituent is bonded to a second modifier having a -SiOSi- structure" was canceled for being directed toward a nonelected species. Applicant does not provide any further arguments in support of the assertion that Yamanaka does not anticipate the claimed invention. Therefore, there is nothing further for the Examiner to rebut.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 24, 2006



TRACY DOVE
PRIMARY EXAMINER